UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/685,186 | 10/14/2003 | Anthony Robert Knoerzer | CFLAY.00193 | 4198 |

22858 7590 06/14/2006

CARSTENS & CAHOON, LLP
P O BOX 802334
DALLAS, TX 75380

| EXAMINER | |
|---|---|
| CHAN, SING P | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1734 | |

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/685,186 | KNOERZER ET AL. | |
| | Examiner | Art Unit | |
| | Sing P. Chan | 1734 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) *1-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 23, 25, and 27 are rejected under 35 U.S.C. 103(a) as obvious over Avery (U.S. 2,391,539) in view of Kon et al (JP 62-62736) and Nash (U.S. 5,536,546).

Regarding claim 23, Avery discloses a method of forming labels. The method includes providing a roll of paper stocks, drawing the paper stocks and laminating the paper stocks to adhesive coated backing. (Page 1, Col 2, lines 31-48) The paper stock is also divided by cutting blades into separated strips that remain in contiguous edge-to-edge relationship as the strips are pressed with the laminating rolls into firm engagement with the adhesive on the backing (Page 2, Col 1, lines 36-50) and the strips can be removed from the backing and applied to any desired article (Page 2, Col 1, lines 62-65) and the laminated is capable of being use as a packaging material, which satisfying the requirement of intended use as a packaging film. Furthermore, Avery recites the other backing material can be used such as Cellophane or Pliofilm (Page 2, Col 1, lines 4-9), which would function as a barrier layer. Avery does not disclose the distance from slitting step to form a strip occurs within 1-24 inches from the pressing step and the paper stock includes a graphics layer. However, Kon et al discloses a method of forming laminated film, which provide a slitting step or slit wheel

just before lamination, (See English Abstract of JP 62-62736) and furthermore, determination of the specific distance between the slitting and pressing steps would have been well within the realm of routine experimentation to one of ordinary skill in the art at the time of the invention in view of the teaching of Kon et al that recognizes that the location, i.e. just before lamination, of the slitting step is ripe for optimization.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize this parameter in order to maintain the edge-to-edge orientation the strips in the method of Avery. Avery as modified by Kon et al is silent as the paper stock includes a graphics layer. However, providing a graphic layer for the paper stock of a label is well known and conventional as shown for example by Nash. Nash discloses a method of forming labels. The method includes providing a web of paper, feeding the paper optionally to a printing stage for printing of indicia (Col 3, lines 30-40), feeding the web to perforating stage and perforating the web, applying release coat to one side, applying adhesive coat to the other side (Col 3, lines 41-45), and slitting the web to form individually webs and taken up collectively (Col 4, lines 18-22), which shows the labels are either printed or not printed with a graphic or indicia layer prior to slitting to individual webs.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to slit the label web material either before or after printing as disclosed by Nash in the method of Avery as modified by Kon et al, which provided that both are functional equivalent expedient.

Regarding claim 25, Avery discloses pressing the paper stocks to the adhesive coated backing (Page 2, Col 1, lines 18-35), which would apply the adhesive to the paper stocks.

Regarding claim 27, Avery discloses the backing is glassine, which includes a release coating. (Page 2, Col 1, lines 4-9) Furthermore, Avery discloses other material such as cellophane or Pliofilm can be used and would required release coating.

3. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Avery (U.S. 2,391,539) in view of Kon et al (JP 62-62736) and Nash (U.S. 5,536,546) as applied to claim 23 above, and further in view of Holmstrom et al (U.S. 4,256,791).

Avery as modified above is silent as to extruding a molten plastic layer between the layers. However, extruding a molten plastic layer between layers as adhesive is well known and conventional as shown for example by Holmstrom et al. Holmstrom et al discloses a method of laminating a material. The method includes extruding a plastic layer, i.e. adhesive layer, between the webs or layers prior to laminating with pressure rollers. (Col 4, lines 15-32)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to extrude the plastic material such as adhesive between the webs or layers of material as disclosed by Holmstrom et al in the method of Avery as modified by the combination of references to provide any means of applying adhesive, which are well known and readily available.

4. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Avery (U.S. 2,391,539) in view of Kon et al (JP 62-62736) and Nash (U.S. 5,536,546) as applied to claim 23 above, and further in view of Wallace (GB 1,399,922).

Avery as modified above is silent as to a release coating is applied to the label or paper stocks. However, applying a release coating to the label well known and conventional as shown for example by Wallace. Wallace discloses a method of forming labels. The method includes applying a release coating to the strip of fabric labels prior to laminating with adhesive coated backing. (Page 1, line 84 to Page 2, line 14)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a release coating on the label as disclosed by Wallace in the method of Avery as modified by the combination of references to provide a label that can be easily be removed from the adhesive coated backing. (See Wallace, Page 2, lines 10-12)

***Response to Arguments***

5. Applicant's arguments, Page 8, lines 4-10), filed April 25, 2006, with respect to the rejection(s) of claim(s) 23 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Nash (U.S. 5,536,546).

6. Applicant's arguments filed April 25, 2006 to claims 24-27 have been fully considered but they are not persuasive.

7. In response to applicant's argument of Avery teaches away from applying an adhesive to the first film layer, the examiner disagrees, since Avery does recite applying

the adhesive on the backing to the label web material, i.e. first film layer, which would applying the adhesive to the first film layer. Furthermore, the claim does not recite if the film is slit and then the adhesive is applied or the adhesive is applied prior to slitting, therefore the examiner is taking the position that the adhesive is either applied after or before slitting, which Avery does not teach away with the embodiment of applying the adhesive after slitting.

8. In response to applicant's argument of Avery does not provide the teaching of a flexible film that can be easily shaped so it can be used in a vertical form fill and seal machine to package low-moisture, shelf-stable food, the examiner disagrees that Avery does not recite flexible film that can be easily shaped so it can be used in a vertical form fill and seal machine to package low-moisture, shelf-stable food since Avery also recites other material for the backing such as Cellophane or Pliofilm (Page 2, Col 1, lines 4-9), which is capable of being formed into package.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the reference is in the general knowledge that it is well known and convention to apply adhesive by extruding the adhesive layer between webs or layers prior to

laminating with pressure rollers, which is a teaching provided by Holmstrom et al. Furthermore, the equipment for such a method would be ready available to anyone of ordinary skill in the art and can easily obtain the equipment to practice the method.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the motivation to combine is provided by Wallace, which allows the label to be easily removed from the adhesive coated backing.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Chan Sing P
SPC

CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER
AU 1734